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10/768,404	01/30/2004	Sven Schwerin-Wenzel	103580.00025/2002P10176	3784
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HOLLAND & KNIGHT LLP				
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BOSTON, MA 02116-3889				
EXAMINER				
STRODER, CARRIE A				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/768,404

Applicant(s)

SCHWERIN-WENZEL ET AL.

Examiner

CARRIE A. STRODER

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on 07 July 2009, wherein:

Claims 1-5 are currently pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-5 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 3 recite a computer program product; however, it does not further recite that the product is embodied upon a computer readable medium, but that the product resides in a computer memory, which implies data. Further, the steps recited seem more appropriate to a method claim than a computer program product claim.

Claim 3 also states "providing a single logical physically distributed information system..." This step does not seem to be able to be accomplished merely by a computer program product residing in a computer memory.

Claims 2, 4, and 5 are rejected as dependent upon claims 1 and 3.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added). Applicant's claims mentioned above are intended to embrace or overlap two different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a computer program product (ex. preamble of claim 1), but recite that it resides on a computer memory, rather than a computer readable medium (generally, a computer program product embodied upon a computer readable medium is interpreted as an article of manufacture). By being embodied in a computer memory, the implication is that applicant is claiming data, which falls into no statutory class. The claims then continue with what appear to be method steps. "A claim of this type is precluded by the express language of 35 USC 101 which is

drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanches (US 20030018510), in view of Kirby et al. (US 20040024629).**

Referring to claim 1:

Sanches teaches

treating two or more information systems as a single logical information system to execute pre-change due diligence and post-change integration of the enterprise change, the enterprise change being at least one of a merger and acquisition (paragraph 55; where "web-based platform" implies the use of the internet, which is interpreted as treating two or more information systems as a single logical information system); and

displaying a user interface on a computer display to conduct a merger activity, wherein the user interface includes features to define a merger and acquisition project from a merger and acquisition template, the features including (paragraphs 143 and 149; "templates for new actions" and "M&A, restructuring, or re-structuring, or re-organization challenges");

creating a task force and assigning team members to the task force (paragraph 40; "define and track group membership");

generating a schedule for the task force to follow (paragraph 291; "scheduling and monitoring the progress of Task objects");

generating project proposals to be completed by the task force (paragraph 55; "create, browse, and manage action plans");
and

publishing information about the task force, schedule, and project proposals to one or more stakeholders (paragraph 55; "...sends key communications and action items to initiative participants via their preferred communications methods...").

Sanches does not teach; however, Kirby teaches a project management tab (paragraph 42; "project tab").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Sanches by using tabs as taught by Kirby because this would provide a manner in which to organize the software, thereby providing the user with an easy-to-use user interface.

Referring to claim 2:

Sanches teaches wherein the user interface is adapted to allow a stakeholder to plan and manage the merger activity, the user interface further adapted to allow a user to access one or more merger resources (paragraphs 50 & 55).

Referring to claim 3:

Sanches teaches
providing a single logical physically distributed information system across one or more information systems of at least two enterprises that are being combined (paragraph 55; where "web-based platform" implies the use of the internet); and

providing displaying a user interface on a computer display to access the single logical physically distributed information system, wherein the single logical physically distributed information system executes one or more pre-merger activities, merger activities, and post-merger activities, wherein the user interface includes features to define a merger and acquisition project from a merger and acquisition template, the features including (paragraphs 55, 143 and 149; "templates for new actions" and "M&A, restructuring, or re-structuring, or re-organization challenges"):

creating a task force and assigning team members to the task force (paragraph 40; "define and track group membership");

generating a schedule for the task force to follow (paragraph 291; "scheduling and monitoring the progress of Task objects");

generating project proposals to be completed by the task force (paragraph 55; "create, browse, and manage action plans"); and

publishing information about the task force, schedule, and project proposals to one or more stakeholders (paragraph 55; "...sends key communications and action items to initiative participants via their preferred communications methods...").

Sanches does not teach; however, Kirby teaches a project management tab (paragraph 42; "project tab").

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Sanches by using tabs as taught by Kirby because this would provide a manner in which to organize the software, thereby providing the user with an easy-to-use user interface.

Referring to claim 5:

Sanches teaches wherein the role of the user further comprises a stakeholder affected with one or more merger closing consequences, wherein the one or more merger activities comprise an organizational restructuring, a personnel redeployment, a merger project management, a procurement management, a personnel retainment, and an integration of operational services (paragraphs 50 & 58; where "managers" is interpreted to include a stakeholder affected with one or more merger closing consequences).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanches (US 20030018510), in view of Kirby et al. (US 20040024629), and further in view of Marpe.

Referring to claim 4:

Sanches and Kirby do not teach; however, Marpe teaches wherein the user interface is adapted to at least one of a role

of the user and a phase of the merger, wherein the user role comprises an internal expert and an external expert of one of the enterprises, wherein the internal expert comprises at least one of an executive, an employee, a manager, an investor, and an owner of one of the enterprises, wherein the external expert comprises at least one of a consultant and an auditor (paragraphs 6-7 and 245-246).

It would have been obvious for a person of ordinary skill in the art (PHOSITA) at the time of invention to modify the teachings of Sanches and Kirby as taught by Marpe because this would provide a user interface adapted to the needs of the user.

Response to Arguments

4. Examiner specifically withdraws the objection to applicant's drawings submitted 09 August 2004.
5. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.
6. Examiner thanks applicant for his specific citation of support for the amendments to the claims.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is

reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
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